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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,727	12/10/2001	Kirsten Smith	0275Y-000418	4703

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EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,727

Applicant(s)

SMITH ET AL.

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 and 6- rejected under 35 U.S.C. 102(a) as being anticipated by Rofrano.

Rofrano teaches a database of products having qualitative attributes subjectively assigned to the products that reflect information about potential users of the products (claim 1) or about intended uses of the products (claim 14). Examiner references column 3; lines 11-17 which state:

“The instant invention uses a rational (sp; relational) database with a very simple model to represent a sales agent's questions, probable or most the (sp) likely generic customer answers to the questions, and relations from the answers to features about the product that would be appropriate for the actual customer if they select a particular answer. This solution operates under two modes. The first or "Build Mode", involves the creation (of) a knowledge base in the form of a question and answer tree with feature relationships. The second mode or "Run Mode", presents the questions and answers to the actual customer as well as constraining products by the feature relationship values.”

Examiner notes that Rofrano's “relations from the answers to the features about the products” represents attributes subjectively assigned to the products. Further, the relations from the answers to the products relate to 1) the users of the product (claim1); reference sample feature constraint tree on column 4; lines 50-57 “Are you interested in high quality or compatibility?” and 2) intended use of the product (claim 14); see sample constraint tree on column 4; lines 50-57, “Will you be using this camera in doors mostly?”

Art Unit: 3627

In addition, since the sales agents input the question via the “Build Mode” the attributes are “subjectively” assigned as required by Applicant’s amendment. To support this Examiner references Applicant’s arguments on pages 9 and 10 of the present amendment, “the qualitative attributes are subject to amendment and elaboration by the manufacturer . . . thus the assignment of the qualitative attributes is subjective.” Since the relations to the to the features of the products is subject to amendment and elaboration by the sales agent, by Applicant’s definition they too are subjective.

Rofrano teaches a server serving the database over a network (claims 1 & 14). Examiner notes that Rofrano teaches that the invention involves an internet electronic catalog (column 1; lines 6-11 and lines 57-59) as such the system must contain a server to serve the database over the internet.

Rofrano teaches a user interface (claims 1 & 14). Examiner references column 3; lines 20-23 which teaches that in Run Mode the system presents questions and answers to the actual customer, therefore the system must include a user interface.

Rofrano teaches an expert system posing questions over the user interface to the shopper and querying the database in response to answers to the questions (claims 1 & 14). Once again, Examiner references column 3; lines 20-23 which states that in Run Mode the system presents questions and answers to the actual customer as well as constraining products by the feature

Art Unit: 3627

relationship values. Examiner notes that constraining the products to the feature relationship includes querying the database in response to the answers provided by the user.

Rofrano teaches wherein the questions posed comprise questions about the user and questions about the product (claim 1) or about the intended use of the product (claim 14), and the selections made by the system are dependent upon the qualitative attributes assigned to the products.

Examiner notes that limitations directed to the types of questions posed by the system represent functional limitations and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must distinguish from the prior art in terms of structure rather than function. Further, a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (reference MPEP 2114 for support of this position).

Therefore, the prior art reference need only be able to perform the intended purpose to anticipate the claimed invention. In relation to the present invention, since the system of Rofrano includes an expert system that poses questions over a user interface to a shopper and queries the database in response to the answers given (i.e. Rofrano teaches all the structural limitations of Applicant's claim), the types of questions posed are merely a design choice. In other words, the structure of the prior art system is capable of posing any type of question and therefore the prior art system anticipates the apparatus of claims 1 and 14.

Art Unit: 3627

Examiner notes that although the types of questions posed (i.e. about the user and about the product) are functional language and Rofrano need not teach them to anticipate the claim, Rofrano does in fact teach posing questions about:

- a. the user, reference the table tree on column 4; lines 50-65 “Are you interested in high quality or compatibility?” This question is specifically geared toward the interests of the user
- b. the product, reference column 3; lines 55-57, “when a feature is selected, all the unique values for that feature are displayed (i.e. such as a limitation of being red, blue or green.”

Examiner notes that the question of a feature (i.e. the color) of the product is a question about the product.

- c. intended use of the product, reference column 5; lines 12-16 “It should be noted that at no time did the customer need to know anything about the various video tape formats of the products they are selecting. They only answer questions about how they would use the video camera.”

Rofrano teaches that the database is a local database directly connected to the server (claim 2). Examiner references column 3; lines 3-5 which states “capturing the knowledge of the best sales agent and storing it with the electronic catalog.” Examiner notes that the knowledge of the best sales agents is captured in a relational database (column 3; lines 12-15) and thus storing it with the electronic catalog represents that the database is local and connected to the server.

Art Unit: 3627

Rofrano teaches that the database is a dynamically updated central database (claim 6).

Examiner once again references column 3; lines 34-52 and notes that as the sales agent enters the questions and answers they are stored in the database, this represents a dynamically updated database. Examiner further notes that as this is the primary database used by the system the database is thus central.

Rofrano teaches a retail database containing price and location information (claim 7).

Examiner once again references column 3; lines 2-5 which teaches an electronic catalog.

Examiner notes that the electronic catalog represents the retail database. Examiner further references table 1 on column 4 and in particular the Price column and notes that this represents the electronic catalog containing price information. Examiner next references column 1; lines 30-35, where Rofrano teaches an example of an electronic catalog used by Prodigy. Specifically, Rofrano teaches, "upon selection, Prodigy™ initiates the order with the supplier". Examiner notes that the electronic catalog must contain location (i.e. supplier) information in order to initiate the order with the supplier.

Rofrano teaches a retail server serving the retail database over the network, wherein price information is provided to the user (claim 8). Examiner once references table 1 on column 4 and column 1; lines 30-35 and asserts that in this example Prodigy™ serves as the retail server serving the electronic catalog (retail database). In addition, price is present via Prodigy to the user as illustrated in table 1 on column 4.

Art Unit: 3627

Rofrano teaches the user interface comprises point and click ordering means (claim 9).

Examiner references column 5; lines 35-36, "This is often followed by the actual customer ordering the product of choice from the presentation". Examiner notes that using an electronic catalog, point and click with a mouse is the way to order the product choice.

Rofrano teaches where the network is the Internet (claims 4 and 16). Reference column 1; lines 55-60, "this type of internet electronic catalog."

Examiner notes that:

- Claims 10, 11, 15, 17, 19, 20, 22 and 23 are require that the product being purchased is a tool.
- Claims 12-13 and 17-23 require that the questions comprise questions about the skill level of the user
- Claims 13, 19, & 20 require questions about the interests of the user;
- Claims 21, 22 and 23 require questions about an occasion for which the product is being purchased

These limitations pertain to the intended use or function of the invention and not the structure.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must distinguish from the prior art in terms of structure rather than function.

Further, a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (reference MPEP 2114 for support of this position).

Art Unit: 3627

Therefore, the prior art reference need only be able to perform the intended purpose to anticipate the claimed invention. In relation to the present invention, since the prior art system includes an expert system that poses questions over a user interface to a shopper and queries the database in response to the answers given, the types of questions posed or the products sold by the invention are a design choice. In other words, the structure of the prior art system is capable of posing question about user interests, skill level or occasion and it is capable of selling tools, therefore the prior art system anticipates the apparatus of claims 10-13, 15 and 17-23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rofrano in view of Microsoft Computer Dictionary.

Rofrano, as described in detail above fails to teach the database connected to the server over a network. Microsoft Computer Dictionary teaches a distributed system is an old and well known noncentralized network consisting of numerous computers that can communicate with one another and that appear to users as part of a single, large, accessible “storehouse” of shared hardware, software and data. Examiner notes that one of ordinary skill would realize that distributing the system provides increased scalability and functionality since the database could then be located anywhere in the world.

Art Unit: 3627

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the connection between the electronic catalog (database) and the virtual sales person (server) as taught by Rofrano to include a distributed system where they are connected over a server as taught by Microsoft Computer Dictionary. On of ordinary skill in the art would be motivated to combine these reference in order to provide increased scalability and functionality.

Rofrano, as described in detail above does not teach that the database is periodically pumped from a dynamic central database. Microsoft Computer Dictionary teaches a backup as a duplicate copy of data made for safeguarding valuable files should the active copy be damaged or destroyed. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the relational database system of Rofrano to maintain the central database as a backup and periodically pump data from the central to the retail database. One of ordinary skill in the art would be motivated to combine these references in order to safeguard the data in the central database in case the active database were destroyed or damaged.

Conclusion

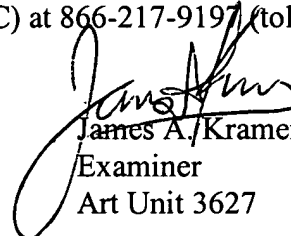
Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James A. Kramer
Examiner
Art Unit 3627

2/24/05

jak